

### **REMARKS – General**

#### **Claim Rejections under 35 USC §102:**

The most recent Office Action (OA) rejects claims 1, 4-10, 13, 18-25, 27-32, 37, 38, 41-43, and 48-50 as being anticipated by Plotnick et al., US Published Patent Application No. 2002/0184047, hereinafter “Plotnick.” Applicants respectfully traverse this rejection.

#### **Claim Amendments:**

Applicant has Amended claim 1, with support for the amendment found in claims 6 and 7 as originally filed, as well as in the specification at page 11, lines 24-27. Applicant has canceled claims 6 and 7. Applicant has likewise amended claim 25, with support found in claims 30 and 31, as well as in the specification at page 11, lines 24-27. Added new claim 52, support found in claim 1 prior to amendment. Applicant has amended claim 30, with support found in claim 25 prior to amendment. Applicant has canceled claim 31.

#### **Applicant Response to Rejections under 35 USC §102:**

In making the traversal to the rejection, Applicant relies upon MPEP §2131, which states, “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). The test is the same for a method or process. Anticipation requires identity between the claimed process and a process of the prior art. The claimed process, including each and every step thereof, must have been described or embodied, either expressly or inherently, in a single reference. *See, e.g., Glaverbel SA v. Northlake Mkt’g & Supp., Inc.*, 45 F.3d 1550 (Fed. Cir. 1995). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by one of ordinary skill in the art to which the invention pertains. *See, e.g., Scripps Clinic & Res. Found. V. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991).

With respect to independent claims 1 and 25, Applicant has amended these claims to recite "...determining content previously ordered or viewed by the user and, in a queue of available barker advertisements, removing unviewed barker advertisements corresponding to the content previously ordered or viewed by the user..." Emphasis added.

Plotnick fails to teach this step. As set forth in the Plotnick at paragraphs [0061] and [0081], and as acknowledged by the Examiner at page 5 of the most recent OA, Plotnick only teaches removing images already viewed a predetermined number of times.

Specifically, at paragraph [0053], Plotnick states, "...it is also possible that an advertiser may over saturate (and turn off) a subscriber by inundating the subscriber with ads for the same product, service or company an excessive number of times in a short period." For this reason, i.e., to avoid showing an ad too many times, at paragraph [0061], "Once the ads have been played from the top of the queue they may be added back to the queue, either at the bottom or some other location depending on the algorithm associated with the ad and the ad queue. The ad queue may also have limitations on the duration of time the ad is in the queue, the number of times the ad is played within a specific time (or other factor), the time frame between displaying the ads, or some other criteria now known or later discovered that would be obvious to one of ordinary skill in the art."

Applicant respectfully submits that this passage there is no teach removing unviewed ads from Plotnick's queue. Plotnick suggests the number of times the ad is played or the time between displaying ads. To be sure, the language "...some other criteria now known or later discovered that would be obvious to one of ordinary skill in the art..." fails teach Applicant's invention as it fails to meet the requirements for prior art under 35 USC §102 for anticipation. Applicant respectfully notes that for anticipation "...every element of the claimed invention must literally be present, arranged as in the claim...The identical invention must be shown in as complete detail as is contained in the patent claim." See, e.g., *Richardson v. Suzuki Motor Company Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

As Plotnick fails to teach Applicant's limitations as recited in independent claims 1 and 25, Applicant respectfully submits that the rejection is overcome. Applicant respectfully requests reconsideration of the rejection in light of these comments.

Claim Rejections under 35 USC §103:

The OA rejects claims 11 under 35 USC §103(a) as being obvious in view of Plotnick in view of Knudson et al., US Published Pat. Application No. 2003/0110499, hereinafter “Knudson.” Specifically, the OA submits that Plotnick teaches all elements of these claims except monitoring a user’s menu or programming guide as the user navigates through these elements. The OA submits that Knudson teaches this, and that it would be obvious to combine Plotnick and Knudson to obtain Applicant’s invention. Applicant respectfully traverses this rejection.

Applicant respectfully traverses the rejection because the combination of Plotnick and Knudson fails to teach the elements of Applicant’s invention as recited in claim 11.

Applicant has shown above that Plotnick fails to teach removal of any unwatched barker advertisements from a queue. Knudson fails to correct this deficiency. Knudson fails to teach a queue of barker advertisements at all. The resulting combination therefore fails to teach each of Applicant’s claimed limitations.

Per MPEP §2141, the guidelines for making a proper determination of obviousness are guided by the decision by the Supreme Court in *KSR International Co. v. Tele-flex Inc.* (KSR), 550 U.S. 398 (2007). MPEP §2141 states that the Court in KSR “...reaffirmed the familiar framework for determining obviousness as set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). The *Graham* analysis requires, in addition to a determination of the scope and contents of the prior art, a determination of the differences between the prior art and an applicant’s invention and the level of ordinary skill in the pertinent art. Where there are differences, an Office Action “...must explain why the difference(s) would have been obvious to one of ordinary skill in the art.” *Id.* Specifically, there must be a “...clear articulation of the reason(s) why the claimed invention would have been obvious.” *Id.*

Here, there is no articulation as to why one would be motivated to employ Applicant’s removal of unviewed barker advertisements with the combination of Plotnick and Knudson without the benefit of Applicant’s disclosure and impermissible hindsight.

The OA rejects claim 51 as being unpatentable under 35 USC §103 in view of Plotnick, Knudson, and Sie et al., US Published Pat. Application No. 2004/0030599,

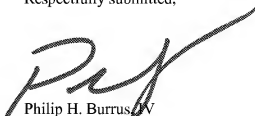
hereinafter “Sie.” Applicant respectfully traverses this rejection for the reasons set forth above as they relate to claim 11. Applicant respectfully notes that Sie fails to teach determining previously viewed content and removing barker advertisements from a queue that correspond to the previously viewed content. Sie teaches away from this as Sie merely teaches thwarting attempts to view commercials already inserted into, and transmitted with, content based upon a user’s authorization. Such advertisements are not barkers selected from a queue where some barkers have been removed, as is recited in Applicant’s independent claims, from which claim 51 depends. For example, at paragraph [0132], Sie prevents users from viewing advertisements that “...appear in linearly scheduled programs or free VOD (FVOD) programs...” Sie does this, for example, where a user “...would pay for the ability to curtail or eliminate some or all advertising.” Sie, paragraph [0133]. Further, when combined with Plotnick and Knudson, the resulting combination employing Plotnick’s queue teaches only the removal of already viewed advertisements as noted above. There is no reason the teaching of Sie would motivate one to do the opposite of the teaching of Plotnick regarding the queue.

For these reasons, Applicants respectfully submit that the §103 rejection is overcome. Applicants respectfully request reconsideration of the rejection in light of these comments.

**CONCLUSION**

For the above reasons, Applicants believe the specification and claims are now in proper form, and that the claims all define patentably over the prior art. Applicants believe this application is now in condition for allowance, for which they respectfully submit.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Philip H. Burrus IV", is written over the typed name.

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